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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,920	10/06/2000	Edward Archibald	HWT-00-001	3041

7590

11/29/2004

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EXAMINER

SAIN, GAUTAM

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,920

Applicant(s)

ARCHIBALD ET AL.

Examiner

Gautam Sain

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-9/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1) Claim 22 is objected to because of the following informalities: Claim 22 depends on itself. For purposes of examination, the examiner assumes the method claim should be dependant on claim 13 instead of claim 22 (itself). Appropriate correction is required.

Claim Rejections - 35 USC § 102

2) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2-1) Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, 22, 25, 26, 27, 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Catona (US 6288319, filed Dec 2, 1999).

Regarding claims 1, 9, 17, 25, Catona teaches choosing ... client node (ie., over a computer network ... selecting a pre-recorded song from a database)(col 2, lines 10-20)(additionally, examiner interprets soundscapes to being pre-recorded songs/noise or aesthetically pleasing sounds to the listener).

Catona teaches recording ... a message (ie., recording a vocal track on the client computer)(col 2, lines 15-20).

Catona teaches mixing ... manner (ie., mixing the vocal track with pre-recorded song ...)(col 2, lines 15-20).

Regarding claims 2, 10, 18, 26, Catona teaches Internet (col 1, lines 45-50).

Regarding claims 5, 13, 21, 27, Cantona teaches act of interleaving ... soundscape (ie., mixer combines the pre-recorded song and the custom audio track)(col 2, lines 66-67).

Regarding claims 6, 14, 22, 28, Catona teaches at least ... back punctuating sound (ie., vocal track; pre-recorded song where the background music in the song must contain sounds that are discerable)(col 2, line 19).

Claim Rejections - 35 USC § 103

3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3-1) Claims 3, 4, 11, 12, 19, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Catona (as cited above), in view of Hsu (US 586006, issued Jan 1999, see IDS).

Regarding claims 3, 11, 19, Cantona does not expressly teach, but Hsu teaches act of ... message (ie., when the message is finished, the background music increases, thus reducing the silence after the completion of the message)(col 3, lines 1-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantona to include reducing the silence after the completion of the

message by increasing the music as taught by Hsu, providing the benefit of automatically providing background for a card message recording system (Abstract section).

Regarding claims 4, 12, 20, Cantona does not expressly teach, but Hsu teaches normalizing said recording message (ie., mixer mixes the background music with the speech signals by controlling their volume ... music fades gradually (col 3, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cantona to include a mixer that mixes the background music with speech signals by controlling their volume as music fades gradually as taught by Hsu, providing the benefit of automatically providing background for a card message recording system (Abstract section).

3-2) Claims 7, 15, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona (as cited above), in view of Dawson (US 6252588, filed Jun 16, 1998).

Regarding claims 7, 15, 23, Catona does not expressly teach, but Dawson teaches determining ... message (ie., running tabulations of the length of recording)(col 14, lines 11-12).

Catona teaches mixing ... punctuating ... , mixing ... punctuating sound ... , mixing ... background ... , mixing ... recorded message ... , mixing ... background punctuating ... level (ie., prerecorded songs and custom audio track, a karaoke-style implementation ... user sings into microphone in recorder. Mixer combines the pre-recorded song and custom audio track into a mixed track.)(col 2, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Catona to include running tabulations of the length of recording as taught by Dawson, providing the benefit of an audio visual e-mail system of the invention that reduces the complexity of sending and receiving audio visual e-mail message to a level that allows a user to send and receive audio visual e-mail with a minimum of inconvenience (Dawson, Abstract section).

3-3) Claims 8, 16, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona (as cited above), in view of Dawson (US 6252588, filed Jun 16, 1998), in view of Hsu (as cited above).

Regarding claims 8, 16, 24, Caton in view of Dawson does not expressly teach, but Hsu teaches act of mixing said ... recorded message (ie., background music fades in volume)(col 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Catona in view of Dawson to include background music that fades in volume as taught by Hsu, providing the benefit of a card message recording system which can automatically provide background music and provide a low-cost, easy-to-implement message recording system which can automatically provide background music and then mix the background music with the speech message for the user (Hsu, col 1, lines 40-50).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOSEPH FEILD
SUPERVISORY PATENT EXAMINER